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| 10/001,558 | 10/24/2001 | Shimei Fan | J6650(C) | 7685 |

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UNILEVER
PATENT DEPARTMENT
45 RIVER ROAD
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EXAMINER

JIANG, SHAOJIA A

| ART UNIT | PAPER NUMBER |
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1617

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/001,558

Applicant(s)

FAN ET AL.

Examiner

Shaojia A Jiang

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,13-17 and 19-27 is/are pending in the application.
- 4a) Of the above claim(s) 23-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,13-17,19-22,26 and 27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1617

DETAILED ACTION

This Office Action is a response to Applicant's amendment and response filed on January 12, 2004 wherein claims 26-27 are newly submitted. Claims 8-12 and 18 are cancelled.

Currently, claims 1-7, 13-17, and 19-27 are pending in this application.

Claims 23-25 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a non-elected invention, as recorded in the previous Office Action May 21, 2003.

Claims 1-7, 13-17, 19-22 and 26-27 are examined on the merits herein.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 27 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant's amendment submitted January 12, 2004 with respect to new claim 27 has been fully considered but is deemed to insert new matter into the claims since the

Art Unit: 1617

specification as originally filed does not provide support for "A composition according to claim 1 wherein the ethoxylated cocomonoethanolamide has EO to an extent selected from the group consisting of 2 EO, 3.5 EO and 4.5 EO groups". The original specification merely discloses "The preferred co-surfactants are ethoxylated nonionic surfactants with ethylene oxide (EO) groups in the range of 2 -12 and most preferably from 2 to 6. Especially preferred nonionic surfactants are ethoxylated fatty amides with the (EO) groups in the range of 2-12, most preferably 2 to 6." (emphasis added) which is whole number without decimal. One of ordinary skill in the art would not understand 3.5 EO and 4.5 EO group in ethoxylated nonionic surfactants with ethylene oxide.

Consequently, there is nothing within the instant specification which would lead the artisan in the field to believe that Applicant was in possession of the invention as it is now claimed. See *Vas-Cath Inc. v. Mahurkar*, 19 USPQ 2d 1111, CAFC 1991, see also *In re Winkhaus*, 188 USPQ 129, CCPA 1975.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 13-17, 19-22 and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reid et al. (USPN 5,085,857) in view of Porter et al.

Art Unit: 1617

Handbook of surfactants, pp.145-146,1991) for the same reasons of record in the previous Office Action October 21, 2003.

Reid et al. (USPN 5,085,857) teaches an aqueous shampoo composition comprising, in addition to water from 2-40% by weight of a surfactant chosen from anionic, nonionic or amphoteric surfactants or mixtures thereof from 0.01% to 3% by weight of cationic conditioning polymer which is a cationic derivative of guar gum, from 0.01 to 10% by weight of an insoluble, non-volatile silicone, present as emulsified particles with an average particle size of less than 2 micrometers, see col. 1 line 67-col.2, line 8. Suitable anionic surfactants are alkyl sulfates, alkyl ether sulfates, alkaryl sulfonates, alkyl succinates, alkyl sulfosuccinates, N-alkoyl sarcosinates, alkyl phosphates, alkyl ether phosphates, alkyl ether carboxylates, and alpha-olefin sulfonates, see col. 2, lines 24-36. The amphoteric surfactants suitable for use in the composition of the invention are alkyl amine oxides, alkyl betaines, alkyl amidopropyl betaines, alkyl sulfobetaines, alkyl glycinate, alkyl carboxyglycinates, alkyl amphopropionates, alkyl amidopropyl hydroxysulfates, acyl taurates and acyl glutamates wherein the alkyl and acyl groups have from 8 to 10 carbon atoms. Examples include lauryl amine oxide, cocodimethyl sulfopropyl betaine and preferably lauryl betaine, cocamidopropyl betaine and sodium cocamphopropionate, see col.2, lines 58-68. The non-ionic surfactants suitable for use in the composition of Reid et al. are condensation products of aliphatic (C8-C18) primary or secondary linear or branched chain alcohols or phenols with alkylene oxides, usually ethylene oxide and generally 6-30 EO. Other suitable surfactants are mono or di alkyl alkanolamides or alkyl

Art Unit: 1617

polyglucosides. Examples include coco mono or diethanolamide, coco mono isopropanolamide, and cocodiglucoiside, see col. 2, lines 47-57. Reid et al. further teaches that the cationic conditioning polymer is a cationic derivative of guar gum, e.g., hydroxypropyl trimonillm chloride, see col.3, lines 5-28. Reid et al. also teaches that the shampoo composition of its invention also comprises an insoluble non- volatile silicone which may be one or more polyalkyl siloxanes, polyalkylaryl siloxanes or mixtures thereof, specific examples include polydimethyl siloxane, see col. 3 line 31-68. Reid et al. also teaches that the average silicone material in this emulsion is less than 2 micrometers, preferable between 0.01 and 1 micrometer, see col. 4, lines 1-9. Reid further teaches that any surfactant material either alone or in admixture m' ay be used as emulsifiers in the preparation of silicone emulsions. Preferred emulsifiers are anionic emulsifiers, see col. 4, lines 15-37. Reid et al. finally teaches that its shampoo composition may also include perfumes, dyes, coloring agents, viscosity modifiers, and herb extracts, see col. 5, lines 1 1-22, see also claims 1-7.

Reid et al. does not teach the particular percentages of the co-surfactant herein. Neither does it particularly teach ethoxylated cocomonoethanolamide.

Porter et al. (Handbook of surfactants, 19.145-146, 1991) teaches that the addition of ethylene oxide to alkanolamides improves dispersability or solubility in water. Porter further teaches that the function of ethoxylated alkanolamides in cosmetic products is similar to alkanolamides as to thickening and foam stabilizing, but possesses improved dispersablity, see page 145-146.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ co-surfactants in the percentages claimed herein. It would have also been obvious to entploy ethoxylated alkanolamides in lieu of alkanolamides.

One of ordinary skill in the art would have been motivated to employ co-surfactants in the percentages claimed herein because the co-surfactants are known to be useful in shampoo composition and optimization of amounts in within the purview of the Skilled Artisan. The Skilled artisan would have been motivated to employ ethoxylated alkanolamides in lieu of alkanolamides, i.e., ethoxylated cocomoethanolamide in lieu of cocomoethanolamide because ethoxylation is known to improve dispersibility, therefore resulting in a more uniform emulsion.

Response to Argument

Applicant's arguments filed January 12, 2004 with respect to this rejection of made under 35 U.S.C. 103(a) of record in the previous Office Action October 21, 2003 have been fully considered but are not deemed persuasive as to the nonobviousness of the claimed invention over the prior art as further discussed below.

Applicant asserts that "Anyone skilled in the art reading the above description of ethoxylated monoalkanolamides would have little incentive to substitute these materials for non-ethoxylated alkanolamides or for ethoxylated alcohols" and "The ethoxylated monoalkanolamides are taught not to have any special properties and would be more costly" and "The motivation for substitution of these materials into the Reid et al.

formulas would be absent". Contrary to Applicant's assertion, one of ordinary skill in the art would acknowledge that ethoxylated alkanolamides are well known and art recognized properties for improving dispersability and/or solubility in water as clearly taught at Handbook of surfactants (see the Handbook of surfactants, page 146 "General properties"), therefore resulting in a more uniform emulsion.

Applicant's arguments regarding that this rejection is hindsight reconstruction of the Applicant's claimed invention have been considered but are not found persuasive. It must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. In re McLaughlin , 170 USPQ 209 (CCPA 1971). See MPEP 2145. As discussed above, the properties and benefit of ethoxylated alkanolamides are well known and art recognized.

Applicant's examples shown in the specification at pages 12-18 herein have been fully considered but are not deemed persuasive as to the nonobviousness and/or unexpected results of the claimed invention over the prior art. Examples herein merely show the several particular compositions but provide no clear and convincing evidence of nonobviousness or unexpected results over the cited prior art since there is no comparison to the same present.

Moreover, as discussed in the previous Office Action, Applicants aver unexpected benefits residing in the claimed subject matter, yet fail to set forth evidence

Art Unit: 1617

substantiating this belief. Evidence as to unexpected benefits must be "clear and convincing" *In re Lohr*, 137 USPQ 548 (CCPA 1963), and be of a scope reasonably commensurate with the scope of the subject matter claimed, *In re Linder*, 173 USPQ 356 (CCPA, 1972). The data provided by Applicants is not reasonably commensurate in scope with the instant claims. Note that the claims recite a co-surfactant which is an ethoxylated cocomoethanolamide with EO ranging from 2 to about 12, whereas the data on pages 13-16 show EO of 2-5. Absent claims commensurate with the showing of unexpected benefits, or a showing reasonably commensurate with the instant claims.

For the above stated reasons, said claims are properly rejected under 35 U.S.C. 103(a). Therefore, said rejection is adhered to.

In view of the rejections to the pending claims set forth above, no claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 1617

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Jiang, whose telephone number is (571)272-0627. The examiner can normally be reached on Monday-Friday from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, Ph.D., can be reached on (571)272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703.872.9307.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-1235.

A handwritten signature in black ink, appearing to read 'S. Anna Jiang', with a long, sweeping horizontal line extending to the right.

S. Anna Jiang, Ph.D.
Patent Examiner, AU 1617
March 25, 2004